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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/676,140 | 09/30/2003 | Leonard J. Stulc | SAM0020/US | 6403 |
| 7590 | | 08/29/2007 | EXAMINER | |
| Dale A. Bjorkman | | KHAN, AMINA S | | |
| Kagan Binder, PLLC | | ART UNIT | | PAPER NUMBER |
| Maple Island Building, Suite 200 | | 1751 | | |
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| Stillwater, MN 55082 | | 08/29/2007 | | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,140

Applicant(s)

STULC, LEONARD J.

Examiner

Amina Khan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) 38-41 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-37 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendments filed on June 7, 2007.
2. Claims 24-43 are pending. Claims 38-41 and 43 have been withdrawn from consideration due to non-elected inventions. Claims 1-23 have been cancelled. Claims 24 and 36 have been amended.
3. Claims 24-37 and 42 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.
4. The 35 U.S.C. 112 rejections, second paragraph, of claims 24-37 and 42 are withdrawn in view of applicant's amendments.
5. Claims 24-37 and 42 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hall (US 4,130,435) for the reasons set forth in the previous office action.
6. Claims 24-37 and 42 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mueller et al. (US 2,922,690) for the reasons set forth in the previous office action.

7. Claims 24-37 and 42 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Coughlin et al. (WO 03/093373) for the reasons set forth in the previous office action.

Election/Restrictions

8. Applicant's election with traverse of Invention I, claims 34-37 and 42, in the reply filed on June 7, 2007 is acknowledged. The traversal is on the ground(s) that no substantial burden is seen in view of the commonality of the claims. This is not found persuasive because the inventions are separately classified and would require separate searches.

The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

9. Applicant's arguments filed regarding the 35 USC 112 first paragraph rejection have been fully considered but they are not persuasive.

The applicant argues that the limitation "in a format ready for application to a desired substrate" does not introduce a new concept to the application and cites "the colorant is provided in a vehicle in liquid or paste form as a coatable colorant composition for the application to a surface to impart color, for example as a coating, ink or paint composition".

The examiner respectfully disagrees. The examiner asserts the term format is much broader in scope than the teaching "in a vehicle in liquid or paste form" and therefore introduces new matter. The rejection of the claims is maintained.

10. Applicant's arguments filed regarding Hall have been fully considered but they are not persuasive.

The applicant argues:

" The Office Action points to Examples 5 and 6, noting that sodium hydroxide is in the solution, apparently asserting that this is the colorless counterion corresponding the present claims. However, sodium hydroxide is not acting as a colorless counterion in the Hall reference. Rather, the use of sodium hydroxide (or for that matter, alkali in general) is common in the dye art for assisting in dissolving dyes that are difficult to dissolve."

The examiner asserts that all components are present in the reaction mixture of Hall and are available to react with one another. The applicant has not provided evidence showing that the sodium hydroxide does not modulate the apparent color of the ionically complexed colorant or comprise the complexed colorant taught by Hall. Applicants' arguments are conclusory statements not supported by factual evidence, see *In re Lindner*, 457 F.2d 506, 173 USPQ 356 (CCPA 1972). The rejections are maintained.

11. Applicant's arguments filed regarding Mueller have been fully considered but they are not persuasive.

The applicant argues:

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"Thus, Mueller teaches a system that requires that the colorant dissociate (and therefore is soluble) in water, which is the liquid carrier of the composition when applied to the fabric substrate. Mueller therefore does not meet the present claims, and the skilled artisan would have no reason to provide a coloring composition comprising a liquid carrier in which the ionically complexed colorant has a solubility of less than 100 parts per million. "

The examiner asserts the Mueller clearly in all the examples describes producing dyes which are readily dispersed in water, not dissolved in water. Mueller clearly teaches a broad range of anionic and cationic dyes and producing dispersion dyestuffs, which are conventionally defined as substantially insoluble in water. The applicant has not provided a showing that the dyestuff have a solubility greater than 100 parts per million. Applicants' arguments are conclusory statements not supported by factual evidence, see *In re Lindner*, 457 F.2d 506, 173 USPQ 356 (CCPA 1972). The rejections are maintained.

12. Applicant's arguments filed regarding Coughlin have been fully considered but they are not persuasive.

The applicant argues:

"Coughlin discloses a composition for imparting improved rheology on pigment based inks and paints. Thus, Coughlin begins with an organic pigment starting material that is not soluble in water, and requires addition of water-soluble dyes as dispersants for the pigment, which "largely overcome the mentioned problems of conventional pigment compositions." See the last paragraph of page 1. "

The examiner asserts the limitation "all of the components of the ionically complexed colorant compound are water soluble prior to being complexed with each other" is simply a product by process limitation. Any difference imparted by the product

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by process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct, not the examiner to show the same process of making, see *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324. The burden is on applicants to show product differences in product by process claims, see *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Best*, 195 USPQ 430 (CCPA 1977); *In re Fessman*, 180 USPQ 324 (CCPA 1974); *In re Brown*, 173 USPQ 685 (CCPA 1972). The rejections are maintained.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AK

AK
August 24, 2007

Lorna M. Douyon
LORNA M. DOUYON
PRIMARY EXAMINER